

U.S. Patent Application Serial No. 10/030,099
Response filed February 2, 2006
Reply to OA dated November 3, 2005

REMARKS

Claims 1-12 are pending in this application. No amendment is made in this Response. It is believed that this Amendment is fully responsive to the Office Action dated **November 3, 2005**.

General comments.

Applicant notes that claim 9 has not been formally rejected or objected to (see Office action summary and the headings of the three claim rejections and the claim objection). However, claim 9 is mentioned in paragraph no. 3 of the Office action, and Applicant has assumed that the rejection of claims 1-6, 10 and 12, was intended to cover claim 9.

Claims 1-6, 10 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 5,829,790 to Phillips in view of USPN 6,214,449 to Otani et al. (Office action paragraphs no. 2-4)

The rejection of claims 1-6, 10 and 12 is respectfully traversed, and reconsideration of the rejection is requested.

Remarks on the present invention

The object of the present invention is to achieve superior printing quality both in fixed information provided by a lithography printing method or the like and in variable information provided by an ink jet recording method.

In the present invention, the following essential features are adopted to accomplish the object:

U.S. Patent Application Serial No. 10/030,099
Response filed February 2, 2006
Reply to OA dated November 3, 2005

A) To **surely** print fixed information on the part of a printing paper on which an ink jet-receiving layer does not exist.

B) To **surely** print variable information on an ink jet-receiving layer.

The reasons why the above-mentioned features, particularly the feature A), are required are as follows: It is impossible to obtain high quality printing on the ink jet-receiving layer by lithography printing method or the like, while it is impossible to obtain high quality printing on the surface of a printing paper, on which printing by lithography printing method or the like is suitable, by ink jet recording method.

From this point of view, in the present invention, there is adopted the feature that at first fixed information is printed on the surface of a printing paper in the absence of ink jet-receiving layer, which leads to sure printing of fixed information on the surface of the printing paper on which the ink jet-receiving layer does not exist, and an ink jet-receiving layer is thereafter provided on a part where variable information is to be printed, which leads to sure printing of variable information on the ink jet-receiving layer.

Distinction of the present invention from the cited references

Phillips '790 discloses printing fixed information and variable information but does not teach or suggest the technical idea that an ink jet-receiving layer is positively provided to obtain high quality printing by an ink jet recording method.

Otani et al. '449 discloses only a dedicated (exclusive) paper sheet for usual ink jet recording method and in Otani et al., printing of fixed information by other printing method is not assumed.

U.S. Patent Application Serial No. 10/030,099
Response filed February 2, 2006
Reply to OA dated November 3, 2005

Neither Phillips nor Otani et al. contains disclosures of the technical idea that the surface of a paper sheet suitable for printing fixed information is utilized as it is and an ink jet-receiving layer is positively provided thereafter, in other words, the structure of a printed matter wherein fixed information is directly printed on a printing paper and an ink jet-receiving layer is thereafter provided on a part where variable information is to be printed. Therefore, the invention of claim 1 is not obvious over the combined disclosures of Phillips and Otani et al.

Further, when a person skilled in the art attempts to obtain a beautiful image by the ink jet recording method of Phillips, the teaching apparently obtained from Otani et al. is only a concept of utilizing a dedicated paper sheet for ink jet recording method. In that case, the person skilled in the art would conclude that there is a problem that most of such exclusive papers are not suitable for the conventional printing method and cannot be used as they are in Phillips' method.

Moreover, with regard to claim 2, Otani et al. discloses an ink jet recording paper having on at least one side of a base paper at least two ink-receiving layers. However, the two ink-receiving layers are characterized in that they are different from each other in thickness and density. Otani et al. does not teach or suggest the subject matter recited in claim 2, that the receiving layer comprises at least two layers containing different ingredients, respectively, at least one of these layers being a receiving layer comprising an ink-absorbing resin as its main ingredient and at least the other layer being a receiving layer comprising an ink-fixing resin as its main ingredient. That is, in Otani et al., there is no suggestion for two or more receiving layers composed of materials having different functions.

U.S. Patent Application Serial No. 10/030,099
Response filed February 2, 2006
Reply to OA dated November 3, 2005

The feature of the present invention that the receiving layer comprises at least two layers containing different ingredients, respectively, at least one of them being a receiving layer comprising an ink-absorbing resin as its main ingredient and at least the other layer being a receiving layer comprising an ink-fixing resin as its main ingredient, thereby providing excellent results, is a entirely different from Otani et al. Applicant submits that there is no suggestion for this limitation in Otani et al.

In addition, with regard to claim 10, Applicant had argued that the combination of Phillips and Otani et al. does not provide the limitation of “printing fixed information and **then** forming the receiving layer ...” The Examiner addresses this argument in the second paragraph on page 6, stating:

“Applicant contends that there is no suggestion for fixed information under ink-receiving layers and is inconsistent with the order as in instant claim 10. However, because Phillips teaches “pre-printing” on paper with lithographic print, printing is indeed on paper and in combination with Otani teaching ink receiving layers on paper to receive ink. [sic]”

Applicant respectfully submits that this argument is not completely clear. Applicant did not deny that Phillips teaches lithographic printing on paper. Applicant's arguments were that the teachings of Phillips, or the combination with Otani, would not yield the sequence in which the fixed information was printed, **then** the receiving layer was formed. The Examiner refers to the teachings of Phillips, but nothing in Phillips suggests that an ink-jet receiving layer would be formed **after** lithographic printing.

U.S. Patent Application Serial No. 10/030,099
Response filed February 2, 2006
Reply to OA dated November 3, 2005

Applicant therefore submits that claims 1-6, 10 and 12 are not obvious over Phillips and Otani et al., taken separately or in combination.

Claims 10 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 5,829,790 to Phillips in view USPN 6,214,449 to Otani et al., and further in view of USPN 6,708,612 to Schmid. (Office action page no. 4)

Reconsideration of the rejection is respectfully requested. Applicant has above provided arguments against the rejection of claims 10 and 12 over Phillips in view of Otani et al. Applicant submits that the additional citation of Schmid for teaching a printing machine with anilox rollers does not provide a suggestion for the limitations not found in the combination of Phillips and Otani et al. In particular, there is no suggestion for the sequence limitation of claim 10 of “printing fixed information and **then** forming the receiving layer for an ink jet recording ink”

Applicant therefore submits that claims 10 and 12 are not obvious over Phillips, Otani et al., and Schmid, taken separately or in combination.

Claims 10 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 5,829,790 to Phillips in view USPN 6,214,449 to Otani et al., and further in view of USPN 6,830,329 to Iwata. (Office action page no. 4)

Reconsideration of the rejection is respectfully requested. Applicant has above provided arguments against the rejection of claims 10 and 12 over Phillips in view of Otani et al. Applicant

U.S. Patent Application Serial No. 10/030,099
Response filed February 2, 2006
Reply to OA dated November 3, 2005

submits that the additional citation of Iwata for teaching processing through a steel and rubber roll does not provide a suggestion for the limitations not found in the combination of Phillips and Otani et al. Applicant notes that in Iwata, the ink-receiving layer is present before the transparent film layer is formed and heated (see abstract).

Applicant therefore submits that claims 10 and 12 are not obvious over Phillips, Otani et al., and Iwata, taken separately or in combination.

Claims 7-8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Office action paragraph no. 5)

Since the rejection of the base claims has been traversed, Applicant has not amended claims 7, 8 and 11 to be independent. Reconsideration of the objection is respectfully requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

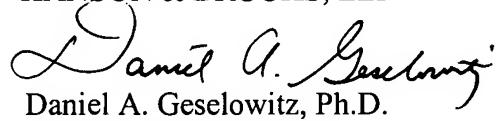
In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other

U.S. Patent Application Serial No. 10/030,099
Response filed February 2, 2006
Reply to OA dated November 3, 2005

fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP


Daniel A. Geselowitz, Ph.D.

Agent for Applicant
Reg. No. 42,573

DAG/xl

Atty. Docket No. **020043**
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



23850

PATENT TRADEMARK OFFICE

H:\HOME\XLU\020\020043\Response in re final OA of Nov. 3, 2005